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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/545,667      | 04/07/2000  | David R. Thomas      | TI-27109            | 9856             |

23494 7590 03/09/2004

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EXAMINER

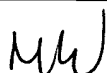
CUFF, MICHAEL A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |   |
|------------------------------|-------------------------------|-------------------------------|---|
| <b>Office Action Summary</b> | Application No.<br>09/545,667 | Applicant(s)<br>THOMAS ET AL. |   |
|                              | Examiner<br>Michael Cuff      | Art Unit<br>3627              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,9-35,37-39 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-7, 9-35, 37-39, and 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***RCE & Amendment***

1. Applicant's Amendment, filed 12/29/03, has been entered. Claims 4, 47 and 48 have been canceled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-7, 9-35, 37-39, and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan in view of Shah-Nazaroff et al.

Kaplan shows all of the limitations of the claims except for specifying the degraded signal for the samples and some details as to how the digital signal is processed.

Kaplan shows, figure 2, a network and method for preview and sale (includes authorization requests and replies) of music products. Kiosk unit 10 acts as a dialogue unit, digital processor, with a product reader including a signal-processing unit. Ranges of audio/video products are available. Database 60 maintains customer files and demand data.

Shah-Nazaroff et al. teaches, figure 5, a system and method for purchasing upgraded media features for programming transmissions. Figure 5 teaches the building of a client history which records the level of quality of a signal based on the price the

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client wishes to spend in order to increase profits by providing alternative quality products.

Based on the teaching of Shah-Nazaroff et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to select a defined quality level (degraded level) in order to increase profits by providing alternative quality products.

The examiner takes official notice the digital signal processes claimed are old and well known and are commonly used in order to manipulate digital products. (For example, the examiner found 2,649 direct hits on A discrete Fourier transforms@, 3,195 hits on A frequency modulator@, and 26 hits on A frequency band rejections@

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Kaplan system to use standard digital processes in order to manipulate digital products.

### ***Response to Arguments***

3. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive.

Applicant asserts that the combination of Kaplan and Shah-Nazaroff et al. does not show defining a level of content degradation or quality dependent upon client history. The examiner does not concur. As stated in the rejection, figure 5, of Shah-Nazaroff et al., teaches the building of a client history. The level of quality is dependent upon this client history.

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Applicant asserts that the combination of Kaplan and Shah-Nazaroff et al. does not show transmitting a degraded evaluation version of the selected product without payment authorization. The examiner does not concur. Kaplan shows the ability to transmit previews and Shah-Nazaroff shows the ability to upgrade quality. The examiner believes that it is an inherent feature that the Kaplan kiosk has the capability to, and would most likely because of cost would, use the lowest quality version during the preview.

Applicant asserts that the combination of Kaplan and Shah-Nazaroff et al. does not include any teaching why supplying the same selected product in degraded and non-degraded versions is advantageous. The examiner does not concur. It is clear from the Shah-Nazaroff et al. reference that the advantage to offering different levels of quality is to be able to make more money by charging more for better quality.

Applicant asserts that the citation of OFFICIAL NOTICE fails to indicate how the known digital signal processes make obvious to use them. The examiner does not concur. Applicant has not properly traversed the Official Notice. From MPEP 2144.03, "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Applicant has not done this. The motivation to use old and well know products and methods are also well known. For example, applicant, in order to properly traverse, should have asserted that "noise insertion circuitry" is not common knowledge in the digital communications field and then further assert that there would be no motivation to have a "noise insertion

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circuit". Ashenfelter et al., figure 3, is provided as an evidence reference that noise insertion circuitry and its effect on sound signals is well known in the communications field. As for motivation, the applicant is relying on an intended use phrase in an apparatus claim to distinguish itself from the prior art.

Applicant repeatedly, pages 18-26, does not properly traverse Official Notice.

### ***Official Notice***

4. In the office action, dated 9/29/03, the examiner took "Official notice" that the digital signal processes claimed are old and well known and are commonly used; and that it would have been obvious to modify the Kaplan system to manipulate digital products. Applicant has not properly traversed the examiner's assertion of official notice. Therefore, per MPEP 2144.03, section C, the examiner must clearly indicate in the next office action that the well known in the art statement, as mentioned above, is taken to be admitted prior art.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Michael Cuff* 3/8/04  
Michael Cuff  
March 8, 2004